

Response Under 37 C.F.R. § 1.116
Expedited Procedure
Art Unit 1771
Application No. 09/322,333
Paper Dated
Reply to Office Action of August 27, 2003
Attorney Docket No. 1217-990766

REMARKS/ARGUMENTS

Claims 5-8 are pending in this application. The specification stands rejected under 35 U.S.C. § 112, second paragraph, for failure to contain a written description of the invention, and claims 5-8 stand rejected under 35 U.S.C. § 112, first paragraph, for being based on a defective specification.

The claimed range of $\tan \delta$, 0.78 to 1.61, is a particularly preferred range, and superior performance is found when that range is obtained. This does not mean that no performance is obtained when the $\tan \delta$ value is outside of the above range. Even when the $\tan \delta$ value is outside of the claimed range, performance consistent with what is disclosed in the specification can be attained. However, the performance of materials with a $\tan \delta$ value outside of the range of 0.78 to 1.61 may not achieve the superior performance obtained with formulations having a $\tan \delta$ value within the claimed range.

The $\tan \delta$ value can depend on many factors, such as the particular photopolymerizable monomer(s) used, the nature of the urethane acrylate oligomer, the combination of the photopolymerizable monomer and the urethane acrylate oligomer and the molar ratio thereof, as well as the compatibility thereof.

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For example, there are many commercially available urethane acrylate oligomers having different properties and different chemical structures. Thus, some types of urethane acrylate oligomers give a $\tan \delta$ value falling within the claimed range in combination with isobornyl acrylate and/or morpholinyl acrylate (see Examples 1-3). However, some types of urethane acrylate oligomers give $\tan \delta$ values outside of the claimed range even when used in combination with isobornyl acrylate and/or morpholinyl acrylate. Contrary to this, some types of urethane acrylate oligomers provide $\tan \delta$ values outside of the claimed range when used in combination with dicyclopentanyl acrylate or dicyclopentenyl acrylate (see Comparative Examples 1 and 2 of the Declaration). However, some urethane acrylate oligomers provide $\tan \delta$ values falling within the claimed range in combination with dicyclopentanyl acrylate or dicyclopentenyl acrylate.

The chemistry of urethane oligomers is a difficult and very complex science. Applicants are specialists in adhesive products but are not specialists in urethane chemistry. Accordingly, Applicants used commercially available urethane acrylate oligomers in combination with photopolymerizable monomers, although some trial and error may be required to obtain substrates satisfying the claimed $\tan \delta$ range based on the general description of the present specification. A skilled artisan will understand that superior performance is obtained when the claimed $\tan \delta$ range is achieved and that performance which is less than superior can be expected when formulations provide a $\tan \delta$ value outside of the claimed range. Nevertheless, some degree

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of performance is observed in each instance. Additionally, the working embodiments reported in the present specification provide sufficient information to understand the claimed product.

“The enablement requirement is met if the description enables any mode of making and using the invention.” Johns Hopkins University v. Cellpro, Inc., 152 F.3d 1342, 1361, 47 USPQ2d 1705, 1719 (Fed. Cir. 1991) (quoting Engel Indus., Inc. v. Lockformer Co., 946 F.2d 1528, 1533, 20 USPQ2d 1300, 1304 (Fed. Cir. 1991)). Applicants disclosed the best mode known to them at the time of filing, in addition to other ways of practicing the invention. Including dicyclopentanyl acrylate and dicyclopentenyl acrylate within the specification does not render the specification inoperable. Dicyclopentanyl acrylate and dicyclopentenyl acrylate may not provide performance equivalent to that obtained when isobornyl acrylate or morpholinyl acrylate or combinations thereof are used, but they still provide a level of performance. Therefore, Applicants disclosed them in the application. Accordingly, the specification does contain a written description of the invention and is in compliance with 35 U.S.C. § 112, second paragraph.

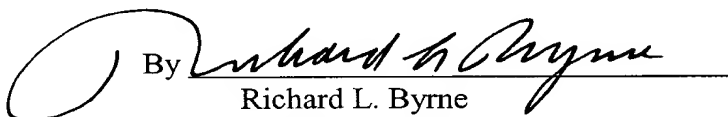
The specification and the claims are in compliance with 35 U.S.C. § 112, first and second paragraphs, because the specification contains a written description of the invention, and of the manner and process of making and using it, in a manner that enables one skilled in the art to practice the invention.

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In view of the foregoing remarks, it is believed that the present application is in condition for allowance. Reconsideration of the rejections and allowance of claims 5-8 are respectfully requested.

Respectfully submitted,

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